

REMARKS

Claims 1-7 and 9-15 are pending in the current application. Claim 1 is the sole independent claim. Dependent claims 14 and 15 have been added. In view of the following remarks, favorable reconsideration and allowance of the present application is respectfully requested.

Initially, Applicant appreciates the Examiner's acknowledgment that all certified copies pertaining to foreign priority claimed under 35 U.S.C. §119 have been received and the indication that the references submitted in the Information Disclosure Statements filed on December 16, 2004 and September 7, 2005 have been considered.

I. NEW DEPENDENT CLAIMS 14 AND 15

By the present amendment, dependent claims 14 and 15 have been newly-added. Applicant submits that claims 14 and 15 are supported at least by International Application No. PCT/JP2003/015893 from which the present U.S. application claims the benefit of priority under 35 U.S.C. §371. A copy of International Application No. PCT/JP2003/015893 was submitted upon filing the present U.S. application. For at least these reasons, Applicant submits that newly-added claims 14 and 15 do not introduce new matter.

II. 35 U.S.C. §112 SECOND PARAGRAPH REJECTION

Claim 13 stands rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential elements.

Applicant submits that claim 13 has been amended to include the formulas (I-a) to (I-o). Applicant further submits that formulas (I-a) to (I-o) may be found on page 54 of International Application No. PCT/JP2003/015893. Thus, the amendments to claim 13 do not introduce new matter.

As such, Applicant submits that the rejection to claim 13 has been overcome. Withdrawal is respectfully requested.

III. EXAMPLE EMBODIMENTS

Example embodiments teach,

As the form of the above-described fine inorganic particles, their average particle size may be preferably in a range of from 100 nm to 300 nm, more preferably in a range of from 150 nm to 250 nm for imparting adequate gloss and transparency to the ink-receiving layer. Inorganic fine particles the average particle size of which is smaller than 100 nm lead to an ink-receiving layer with reduced ink absorbency that, when printed by a printer of high ink ejection rate or by a printer of high-speed output, ink bleeding and beading may occur on the resulting image. An average particle size greater than 300 nm, on the other hand, may result in an ink-receiving layer with lowered transparency and reduced gloss. When the ink-receiving layer is formed of a multiplicity of layers in the present invention, the fine inorganic particles employed in the respective layers may be the same or different in kind and/or shape.

Specification, p. 20, l. 35 – p. 21, l. 14.

IV. 35 U.S.C. §103(a) REJECTION – SUZUKI, WINNIK AND ISHIDA

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki et al. (hereinafter ‘Suzuki’), U.S. Patent Publication No. 2002/0008753, in view of Winnik et al. (hereinafter ‘Winnik’), U.S. Patent Publication No. 2002/0182378, and Ishida et al. (hereinafter ‘Ishida’), U.S. Patent No. 5,145,518. Applicant respectfully traverses the rejection.

A. INDEPENDENT CLAIM 1

Applicant submits that independent claim 1 has been amended to recite “said fine inorganic particles are made of at least one selected from the group consisting of aluminum hydrate of the boehmite structure and aluminum hydrate of the pseudo-boehmite structure each of which has an average particle size of 100 to 300 nm.” Applicant submit that the above-identified features recited in amended independent claim 1 are not taught, or suggested, in the art cited by the Examiner.

i. SUZUKI

Referring to paragraphs [0021] – [0024] of Suzuki, the Examiner asserts that Suzuki teaches “[t]he fine inorganic particles are made of at least one of silica, alumina and aluminum hydrate of the boehmite structure or pseudo-boehmite structure...” Action, p. 3. Applicant respectfully disagrees.

Applicant submits that Suzuki provides no teaching that suggests the inorganic particle may be at least one of an “aluminum hydrate of the boehmite structure and aluminum hydrate of the pseudo-boehmite structure” as recited in amended independent claim 1.

Furthermore, with regard to the average particle size, Applicant submits that Suzuki teaches away from the claimed invention. That is, paragraph [0024] of Suzuki (as relied upon by the Examiner) states “[a]n average primary particle size of the fumed silica to be used in the present invention is less than 30 nm, and in order to obtain a higher gross, it is preferably less than 15 nm. Those having an average primary particle size of 3 to 15 nm...[are] more preferably used.” Emphasis Added. Thus, based on the teachings of Suzuki, one of ordinary skill in the art would not be motivated to use a particle having an average primary particle size greater than 30 nm.

Applicant reminds the Examiner of MPEP §2144.05(III) which states, “[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).”

ii. SECONDARY REFERENCES

Applicant submits that the secondary references, Ishida and Winnik, fail to teach or suggest i) an aluminum hydrate of the boehmite structure or aluminum hydrate of the pseudo-boehmite structure, or ii) an average particle size of 100 to 300 nm. As such, Ishida and Winnik fail to remedy the deficiencies of Suzuki with respect to amended independent claim 1.

Accordingly, Applicant submits that Suzuki in view of Ishida and Winnik fails to teach or suggest “said fine inorganic particles are made of at least one selected from the group consisting of aluminum hydrate of the boehmite structure and aluminum hydrate of the pseudo-boehmite structure each of which has an average particle size of 100 to 300 nm” as recited in amended independent claim 1.

Reconsideration and withdrawal of the rejection to amended independent claim 1, and claims 2-7 and 9-12 at least by virtue of their dependency on independent claim 1, are respectfully requested.

CONCLUSION

Accordingly, in view of the above, reconsideration of the rejections and allowance of each of claims 1-7 and 9-15 in connection with the present application is earnestly solicited.

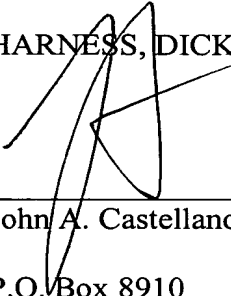
Should there be any matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By



John A. Castellano, Reg. No. 35,094

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

JAC/CDW